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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/870,283      | 05/30/2001  | Sumiko Imai          | 261A 3103           | 7309             |

7590 01/04/2006  
Koda & Androlia  
Suite 1140  
2029 Century Park East  
Los Angeles, CA 90067-2983

EXAMINER

BOVEJA, NAMRATA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/870,283 | <b>Applicant(s)</b><br>IMAI, SUMIKO |  |
|                              | <b>Examiner</b><br>Namrata Boveja    | <b>Art Unit</b><br>3622             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This office action is in response to communication filed on 10/13/2005.
2. Claims 1-8 are presented for examination.

#### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 teaches a computer system for designing an entire area of a subway station, registering various designed components, **printing** components, and **pasting** components in the subway station. The printing and pasting functions are not enabled by the computer system. Specifically, it is unclear how can a computer system carry out the task of **pasting** something on a wall.
4. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

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Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 2 recites a computer graphics system for designing an entire area of a subway station. However, **no steps are provided** that need to be taken in designing the entire area of a subway station. Furthermore, the claim recites components that are design data, but it is unclear **what is done with the components in relation to the subway design or the program and if the components are claimed as the applicant's invention**. Therefore, it is unclear what is the applicant claiming.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under U.S.C. 103(a) as being unpatentable over Bourdelais in view of Jepson and further in view of Official Notice.

In reference to claim 1, Bourdelais discloses the method for a central computer system for designing different rooms in a house including the walls of a room, furniture (size, material, color), paintings, pictures, floors, and the aisles of a room (col. 2 lines 3-16 and 64-67, col. 3 lines 4-12, 27-30, 34-36, and 55-64, col. 5 lines 50-59, col. 6 lines 34-57, col. 8 lines 35 to col. 12 lines 37, and Figures 1-15); registering (i.e. saving) various created designs in a database as

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components (i.e. providing a furnishings tool bar with registered furnishing designs) (col. 9 lines 35-40, col. 12 lines 31-37, col. 5 lines 21-22, and Figures 6 and 14); and pasting said components together on a specified location (i.e. a specific room in the house) as needed in order to design the layout for different rooms in the house (col. 10 lines 13-24).

Bourdelaïs does not specifically state the use of a central computer and graphics system to design an entire area of a subway station. Jepson teaches the use of a computer system and simulation technology (computer graphics systems and software) in medium to large-scale urban design and planning projects from an architectural context that specifically include a subway transit-modeling project (Jepson page 166 lines 45-58). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use a computer graphics system like the one invented by Bourdelaïs for designing the entire area of a subway system to achieve cost savings from being able to visualize multiple scenarios without having to physically set up each of them.

In reference to claim 1, Official Notice is taken that it is old and well known to use simulation tools (computer graphics systems and software) and computer systems such as Adobe Photoshop or Illustrator extensively in the design field for the storage of handwritten designs and photographs, the creation of designs directly on a computer (i.e. pasting components together at a specified location to design any scenario) and the modification of previously stored designs (i.e. registered in a database as components) (also admitted by applicant's prior art

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on Page 1 lines 21-26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use a computer graphics system to design a subway system to enable designers to access stored components and quickly put together various design models of public and private spaces such as a subway station or a housing development project.

6. **Disclaimer:** Claim 2 was found to be deficient under U.S.C. 112 first paragraph. To the extent the claimed invention was understood, the following art was applied.

Claim 2 recites *the* computer graphics system for designing an entire area of a subway station, wherein subway premises are divided into blocks of certain sizes for design purposes.

In reference to claim 2, Bourdelais teaches using a computer graphics system to design rooms of a house (col. 2 lines 3-16 and 64-67, col. 3 lines 4-12, 27-30, 34-36, and 55-64, col. 5 lines 50-59, col. 6 lines 34-57, col. 8 lines 35 to col. 12 lines 37, and Figures 1-15), wherein the house premises are divided into blocks of certain sizes (Figures 4-14) (i.e. living room is a different size than a bedroom or kitchen) for design purposes).

Bourdelais does not specifically state the use of a central computer and graphics system to design an entire area of a subway station wherein subway premises are divided into blocks of certain sizes for design purposes. Official Notice is taken that it is old and well known to divide subway premises into blocks of certain sizes for design purposes to enable planning of sections of the

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station in sub units to divide out tasks among different subcontractors and to allow multiple construction related tasks to take place simultaneously. It is also well known to use computer graphics systems to develop simulations of different scenarios such as a subway station design or a building design to enable designers to visualize the scenarios without having to construct and then view each of the scenarios in real time. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of a computer graphics system for designing an entire area of a subway system to save designers time and money by illustrating designs for certain blocks of areas virtually without requiring that each of the designs be physically implemented in real-life.

7. Claim 3 recites the computer graphics system, wherein background and foreground are separately designed; making a contract exclusively with a single advertiser for the entire area of a subway station, advertiser's merchandise are designed into components of the foreground; and the components, which are the foregrounds, are laid out on the background in a storytelling continuity, starting at an entrance and ending at station platforms, in accordance with a flow of passengers.

In reference to claim 3, Official Notice is taken that it is old and well known to design a background and foreground separately and to have a single advertiser sponsor an entire area of a subway system to ensure that an advertisement is easily visible and to surround the audience with the brand as done for example by Microsoft in the "station domination" wallpapering campaign

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conducted at a San Francisco subway station with recruiting ads. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to design the background and foreground separately and to contract exclusively with a single advertiser to make it easily visible and to popularize a brand or a message among the target audience.

8. Claim 4 recites *the* computer graphics system for designing an entire area of a subway station, wherein in an event of a change in advertisers or of an advertised content, redesign is achieved efficiently by means of replacing advertising designs, which are said components, while leaving the background as is.

In reference to claim 4, Official Notice is taken that it is old and well known to replace advertising designs, which are said components, while leaving the background as is, since advertisements are posted for a given period of time based on the payment received from the advertiser, and then the advertising space is rented out to the next advertiser. Furthermore, advertisements get old and need to be modified with new advertisements that are in sync with the changing dynamics of the needs and interests of consumers. This is done for example with advertising displays featured on trucks and billboards that are provided with a self-tensioned display panel and mounting which allows convenient installation and removal. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to achieve redesign by replacing advertising designs, which are said components, while leaving the



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background as is to speed up the process of changing advertisements provided by different advertisers for a specific duration of time.

9. Claim 5 recites the *computer graphics system* wherein wrapping sheets with a strong adhesive are used for the background that remains the same for a long period of time; wrapping sheets with a removable adhesive are used for the foreground that has a high probability for replacement; and only foreground wrapping sheets are replaced upon a change in advertising content; thus ensuring a flexibility of construction work.

In reference to claim 5, Official Notice is taken that it is old and well known to use wrapping sheets with a strong adhesive for the background (i.e. wallpaper with adhesive backing) and wrapping sheets with a removable adhesive for the foreground to facilitate quick and easy replacement of advertisements (i.e. a poster pasted on a wall that can be peeled off without damaging the wall paper behind, or that can be posted to the wall with the use of Velcro fasteners. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have utilized the design method wherein wrapping sheets with a strong adhesive are used for the background that remains the same for a long period of time; wrapping sheets with a removable adhesive are used for the foreground that has a high probability for replacement; and only foreground wrapping sheets are replaced upon a change in advertising content to speed up the process of displaying advertisements and changing the displays on a scheduled basis.

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10. Claims 6 and 7 teach *the* computer graphics system, wherein advertisements, which are printed, painted, or use light-storing pigments, are posted on walls along an escalator, a space between the wall and a handrail belt of the escalator, a space between escalators, steps at entrance and exit of the escalator, in an area extending into a tunnel from an entrance thereof at an end of a platform or in a block within a tunnel, and other areas around the escalator, thus simultaneously having an advertising effect and a traffic-guidance effect of a guide sign during normal times and during periods of power outage and causing the advertisements to stand out in the dark through luminescence of said light-storing pigments. The location of advertisement posting is not given any weight, since this is just an intended use of the light-storing pigments.

In reference to claims 6 and 7, Official Notice is taken that it is old and well known to use paints with light-storing pigments to achieve beautiful, unusual, and dramatic effects as seen in decorative, artistic, and advertising displays. For example, black light (the popular name for near-ultraviolet radiant energy which falls just outside the visible spectrum that makes certain materials "fluoresce" that is "emit visible light" when it falls on them) is used in the theater by artists. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have utilized light-storing pigments in printed or painted advertisements to achieve an attractive, radiant, and dramatic advertising effect for the human eye.

11. Claim 8 teaches *the* computer graphics system, wherein a gutter is installed on an underground wall in order to prevent soiling thereof by water

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leakage, and an entire area, including the gutter is designed as one picture in such a way that the gutter becomes inconspicuous.

In reference to claim 10, Official Notice is taken that it is old and well known to install a gutter to prevent soiling by water leakage and to include the gutter in a design as one picture in such a way so that the gutter becomes inconspicuous to make the display visually appealing to the human eye as done with transformers located in the front yards of homes that are hidden by the use of rocks and bushes that blend in the transformer into the background so that its presence does not take away from the beauty of the front yard and of the residential property. It would have obvious to a person of ordinary skill in the art at the time of the applicant's invention to installed the gutter for preventing soiling by water leakage in such a way that the gutter becomes inconspicuous in order to maintain the neat and clean appearance of a subway station.

**Response to Arguments**

12. After careful review of Applicant's remarks/arguments filed on 08/31/2005, the Applicant's arguments with respect to claims 1-21 have been fully considered but they are not persuasive. Amendments to the claims have been entered and considered.

13. The objection in reference to including line and paragraph numbers in the specification is cancelled, since this is suggested but not required.

14. Applicant argues that the amendments made to the claims address the requirements of 35 U.S.C. 112, first paragraph. However, the amendments

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necessitate new 35 U.S.C. 112 rejections as detailed previously in reference to claims 1 and 2.

15. In reference to claims 1-8, applicant argues that Bourdelais and Jepson do not disclose the various limitations addressed in these claims. First of all in reference to claim 1, Jepson specifically gives an example of using the computer graphics system for modeling a subway/train station (see Page 166 lines 45-58). Furthermore, applicant admitted in the prior art on Page 1 lines 21-26 that any software program including Adobe Photoshop or Illustrator can be used to design the layout of the subway system. If the applicant contends that the computer graphics programs such as those recited by Bourdelais and Jepson are not capable of being used to design a subway station, the examiner would like to invite the applicant to specifically point out and claim what specific software code or program the applicant is using to develop the subway station design and why the systems disclosed in the references would not be able to carry out that same function.

Additionally, in reference to claims 1-8 and applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (**Bourdelais, Jepson, and Official Notice**). See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further in reference to claims 1-8, in response to applicant's argument that Bourdelais is nonanalogous art, it has been held that a prior art reference must

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either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Bourdelais reference is indeed considered analogous, since it is solving the same problem as the applicant of designing the layout for a given area (i.e. a house versus a subway station). Therefore, the claim rejections made under 35 U.S.C. 103 for claims 1-8 are sustained.

### **Conclusion**

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Point of Contact**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.

December 21<sup>st</sup>, 2005

  
RETTA YEHDEGA  
PRIMARY EXAMINER